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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|-----------------------|---------------------|------------------|
| 10/070,039 | 10/22/2002 | Cristina Alonso-Alija | Le A 33 893 | 9715 |
| 27941 | 7590 | 05/30/2006 | EXAMINER | |
| JEFFREY M. GREENMAN VICE PRESIDENT, PATENTS AND LICENSING BAYER CORPORATION 400 MORGAN LANE WEST HAVEN, CT 06516 | | | PUTTLITZ, KARL J | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1621 | |
| DATE MAILED: 05/30/2006 | | | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/070,039 | ALONSO-ALIJA ET AL. | |
| | Examiner | Art Unit | |
| | Karl J. Puttlietz | 1621 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on _____.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.
 4a) Of the above claim(s) 1,2,5 and 10-18 is/are withdrawn from consideration.
 5) Claim(s) ____ is/are allowed.
 6) Claim(s) 3,4 and 6-9 is/are rejected.
 7) Claim(s) ____ is/are objected to.
 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

| | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION***Election/Restrictions***

Notwithstanding Applicant comments regarding the amount of exemplified species in the specification that are claimed in the elected Group, Applicant has still not advanced any arguments that a common structure is present in all of the claimed compounds, i.e., a corresponding technical feature. In this regard, unity exists when there is a technical relationship among the claimed inventions involving one or more corresponding special technical features. A special technical feature is a contribution which each of the inventions, considered as a whole, makes over the prior art. See, PCT Rule 13.2 and M.P.E.P Appendix AI, § 206 and Annex B.

The situation involving the so-called "Markush practice" wherein a single claim defines alternatives (chemical or non-chemical) is governed by PCT 13.2. In this special situation, the requirement of a technical interrelationship and the same or corresponding special technical features as defined in Rule 13.2 shall be considered to be met when the alternatives are of a similar nature.

Specifically, when the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of a similar nature where the following criteria are fulfilled: (A) all alternatives have a common property or activity, and (B) a common structure is present, i.e., a significant structural element is shared by all of the alternatives, or in cases where the common structure cannot be the unifying criteria, all alternatives belong to a recognized class of chemical compounds in the art to which the invention pertains.

A significant structural element shared by all of the alternatives refers to cases where the compounds share a common chemical structure which occupies a large portion of their structures, or in case the compounds have in common only a small portion of their structures, the commonly shared structure constitutes a structurally distinctive portion in view of existing prior art. The structural element may be a single component or a combination of individual components linked together. In this connection, Applicant has not demonstrated a common structure with regard to the compounds of Formula (I), and thus, there is no unity between the claimed compounds.

However, the examiner will expand the elected compounds to include alkylene.

The rejection under section 102 is maintained and repeated below. Applicant's remarks in connection with this ground of rejection are also addressed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

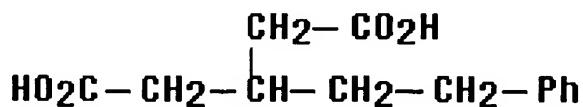
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 3, 4, and 6-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Jones et al., Canadian Journal of Chemistry (1979), 57(9), 1025-32, Abstract, [retrieved

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on 31 October 2005] Chemical Abstracts, Columbus, OH, USA, Abstract Number 1979:523603 (Jones).

Jones teaches the following compound which anticipates the rejected claims within the meaning of section 102:



Applicant argues that the above compound does not anticipate the present claims as modified by the restriction requirement because it does not contain a double bond in the portion corresponding to the "W" portion of formula (1).

However, the above compound is well within the compounds elected within Group II since the examiner has expanded this group to include alkylene. Moreover, with regard to Applicant's comments about an alleged requirement for a double bone in the definition of W, the examiner points out that W can be alkylene as per the expanded elected group, which is defined in the specification as a straight-chain or branched hydrocarbon bridge having 1 to 20 carbon atoms, see page 50. Accordingly, the above compound anticipates the claim.

The Double patenting rejection is maintained and repeated below. Applicant's comments in connection with this ground of rejection are also addressed.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 3, 4 and 6-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 7 and 14-19 of copending Application No. 10/070033 (conflicting application). Although the conflicting claims are not identical, they are not patentably distinct from each other. While the compounds covered in the conflicting application are of a different scope, the conflicting application covers compounds that teach or suggest the instant compounds of the rejected claims with the requisite particularity and guidance that the instant compounds would have been within the motivation of those of ordinary skill, and therefore, *prima facie* obvious.

The conflicting compounds are well within the compounds elected within Group II since the examiner has expanded this group to include alkylene.

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THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karl J. Puttlitz whose telephone number is (571) 272-0645. The examiner can normally be reached on Monday to Friday from 9 a.m. to 5 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman K. Page, can be reached at telephone number (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Karl J. Puttlitz
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